



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,508	06/30/2003	William P. Addiego	SP03-070	2155
22928	7590	11/02/2005	EXAMINER	
CORNING INCORPORATED			NGUYEN, CAM N	
SP-TI-3-1				
CORNING, NY 14831			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,508

Applicant(s)

ADDIEGO ET AL.

Examiner

Cam N. Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 09, 2005 (an amendment/response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 20-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' amendment and remarks, filed August 09, 2005, has been made of record and entered. Claims 14-15, 17, & 19 have been amended.

Claims 1-37 are currently pending in the application.

Status of Withdrawn Claims

2. This application contains claims 20-37 which drawn to an invention nonelected with traverse in Paper No. April 15, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102(e)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3, 5-7, 10-14, & 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Davies et al., "hereinafter Davies", (US Pat. 6,793,728 B1).

Davies discloses a composition for coating a metal substrate which is intended to be fabricated or overcoated, said composition comprising a silica binder and zinc powder and/or zinc alloy, etc. (see col. 17, claim 1). Suitable binder materials including the alkoxysilanes and/or orthosilicates, such as tetraalkoxysilane (see col. 7, ln 36- col. 8, ln 10).

Davies discloses the claimed supported catalyst, thus anticipates the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 8-9, & 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies et al., "hereinafter Davies", (US Pat. 6,793,728 B1), as applied to claims 1-3, 5-7, 10-14, & 17-19 above, and further in view of Birkenstock et al., "hereinafter Birkenstock", (US Pat. 4,407,733).

Davies discloses a composition as described above, except for the following

differences.

Regarding claims 4 & 15, Davies does not disclose the claimed transition metals. However, it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have employed such known transition metals to achieve an effective catalyst in Davies because they are known as useful catalytically active metals for making supported catalysts, as evidenced by Birkenstock (see Birkenstock at col. 20, claims 11-27).

Regarding claims 8-9 & 16, Davies does not disclose the claimed inert support materials. It would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have utilized such known catalyst support in Davies because alumina has been shown by Birkenstock a useful catalyst support material for preparing similar catalysts (see Birkenstock at col. 20, claim 12).

Response to Applicants' Arguments

7. Applicants' amendment and response filed on August 09, 2005 has been fully considered, but not deemed persuasive for the following reasons.

Applicants' urging on the Davies reference is noted. It is not found persuasive because Davies discloses that "All or part of the zinc powder can be replaced by a zinc alloy. The amount of zinc powder and/or alloy in the coating is generally at least 10% and may be up to 90% by volume of the coating, on a dry film basis. The zinc powder and/or alloy can be substantially the whole of the pigmentation of the coating or can comprise up to 70% on a dry film basis with the coating also containing an auxiliary

Art Unit: 1754

corrosion inhibitor, which can be a molybdate, phosphate, tungstate or vanadate...

and/or a filler such as silica, etc." (see Davies at col. 4, ln 39-54). It is considered

Davies teaches ^{the coating} not only the zinc powder, but it can be a "zinc alloy", and "zinc alloy" is a catalytic active material. In response to applicants' argument regarding the "filler" disclosed in the Davies reference, it is considered the "filler" is not required because the reference teaches that "the zinc powder and/or alloy can be substantially the whole of the pigmentation of the coating" (see col. and ln above).

Upon carefully reviewed of the Davis reference, it is considered the rejection made is still proper. Therefore, it is maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1754

Conclusion

9. Claims 1-37 are pending in the application. Claims 1-19 are rejected. Claims 20-37 are withdrawn due to nonelected (distinct) invention. No claims are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *Cnn*
October 31, 2005

Cam Nguyen
CAM N. NGUYEN
PRIMARY EXAMINER

Art Unit - 1754